

## Remarks

### Preliminary Matters

Claims 2-4, 8-10, and 27-31 are presented for reconsideration. Claims 1, 5-7, and 11-26 have been canceled.

### Rejections Under 35 U.S.C. § 103

#### First Rejection.

Claims 2-4, 8, 27, 28 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mori *et al.*, U.S. Patent Application Publication No. 2003/0055695 (Mori), in view of Etzion *et al.*, U.S. Patent No. 6,604,093 (Etzion) and in further view of Kevin Crowston, *A taxonomy of organizational dependencies and coordination mechanism* (Crowston).

Applicant respectfully traverses this rejection. The rejection over Mori in view of Etzion and Crowston rests on the assumption that Etzion is applicable as prior art against the present patent application under 35 U.S.C. §102(a) and/or 102(e). Etzion is inapplicable under section 102(a), however, because of common inventorship with the present patent application and furthermore because the present invention was made before the publication date of Etzion. (Either of these grounds is by itself sufficient to disqualify Etzion as prior art in the present case.) Etzion is inapplicable under section 102(e) on the same grounds of common inventorship, and furthermore is disqualified as prior art under 35 U.S.C. §103(c) on account of having the same assignee as the present patent application.

These arguments are explained in greater detail hereinbelow.

1 Etzion is commonly assigned with the Application.

Etzion was filed Dec. 27, 1999, and was first published on its issue date, 5 August 2003, less than one year prior the filing date

hereof (30 October 2003). Etzion would tentatively qualify as prior art under 35 U.S.C. § 102(e) as applied to 35 U.S.C. § 103. However, Applicant has noted that Etzion is commonly assigned to International Business Machines Corporation (Reel/Frame 010493/0756) with the Application (Reel/Frame 014668/0833). At the time that they made the present invention, the inventors were under an obligation to assign the invention to International Business Machines Corporation. Applicant therefore believes that Etzion is not prior art as to the Application pursuant to 35 U.S.C. § 103(c) (1).

2. Applicants invented the subject matter of the claims hereof prior to the patenting of Etzion.

A Declaration under 37 C.F.R. § 1.131 is submitted herewith to prove conception of the invention prior to the issue date of Etzion coupled with due diligence from prior to the issue date of Etzion to the filing of the Application. On the basis of this Declaration, Etzion is inapplicable as prior art against the Application under 35 U.S.C. § 102(a).

3. Etzion is a disclosure of the inventors' own work.

The two co-inventors of Etzion, Opher Etzion and Asaf Adi are both co-inventors of the Application. The Application has other two co-inventors, Guy Sharon and Dagan Gilat, who are not co-inventors of Etzion.

MPEP 2132(III) states that in considering the authorial entity in a prior publication, "The entity need only differ by one person to be 'by others,'" citing *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). This statement, however, does not logically imply its converse, i.e., the mere fact that the inventive entity in a prior publication is not identical to that in a later patent application

does not necessarily imply that a given disclosure in the prior publication is "by others" with respect to the later application. On the contrary, the case law makes clear that disclosures made by inventive entity A in an earlier patent application will not generally be considered to be "by another" in a later joint patent application by entities A and B.

In our case, "inventor "A" is Etzion and Adi, while inventor "B" is Sharon and Gilad.

In regard to the question of what defines "different inventive entities," MPEP cites *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966). In that case, Land and Rogers had filed separate, individual patents, which were then cited together in rejecting their later joint application under 35 U.S.C. 103. The court made clear in this case, however, that this decision was specific to the unusual fact pattern behind this particular obviousness rejection. More generally speaking, the court stated:

The question here is not merely whether A or B, individually, is or is not "another" to A & B jointly on a theory of "different legal entities." Of course they are different "entities" in the sense that an invention made jointly by A & B cannot be the sole invention of A or B and vice versa, and certain legal consequences flow from such fact, such as who must apply for patent. But it is inescapable fact, too, that when A applies for a patent jointly with B he still has in his head all the information he had as individual inventor A, the same being true of B. If as individuals they apply for patents on individual inventions during a period when they are working together on their joint inventions, they also have in their several heads full knowledge of what they have

done jointly. When the joint and sole inventions are related, as they are here, inventor A commonly discloses the invention of A & B in the course of describing his sole invention and when he so describes the invention of A & B he is not disclosing "prior art" to the A & B invention, even if he has legal status as "another." (Page 880, emphasis added.)

More recently, the Court of Appeals for the Federal Circuit (CAFC) followed the guidance of *In re Land* in *Applied Materials Inc v. Gemini Research Corporation* 835 F.2d 27915 U.S.P.Q.2d 1816, 5 U.S.P.Q.2d 1127. In this case, the District Court found U.S. Patent 4,081,313, to McNeilly, Benzing, and Locke, to have been anticipated by U.S. Patent 3,623,712, to McNeilly and Benzing (exactly the fact pattern of the present patent application). The CAFC reversed the District Court rejection, pointing out that "if the invention claimed in the '313 patent is fully disclosed in the '712 patent, this invention had to be invented before the filing date of the '712 patent and the latter cannot be 102(e) prior art to the '313 patent." It is logically not possible for an inventor to disclose an invention before he or she has actually invented it. Although *Applied Materials* deals with a rejection under 102(e), exactly the same criterion applies to 102(a) prior art.

Other cases supporting the above analysis include *In re Blout and Rogers*, 333 F.2d 928, 52 CCPA 751 (1964), and the above-mentioned *In re Katz*.

Thus, to conclude, by parallel with *Applied Materials*, if Etzion and Adi did actually disclose the invention of claims 2-4, 8, 27, 28 and 30 in their earlier patent, U.S. Patent No. 6,604,093, as the Examiner asserts, this disclosure could not logically have taken place before they actually made the invention

(presumably together with Sharon and Gilad). Therefore, the requirement of 35 U.S.C. §§ 102(a), 102(e) that the invention have been described by others "before the invention thereof by the applicant" cannot possibly be fulfilled by the cited reference, and the rejection should be withdrawn.

### **Second Rejection.**

Claims 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mori in view of Etzion and Crowston, and further in view of H. Herbst, G. Knolmayer, T. Myrach and M. Schlesinger, *The specification of business rules: A comparison of selected methodologies*, (Herbst) and Nye, U.S. Patent No. 6,341,279 (Nye).

With the removal of Etzion for the reasons presented above, this rejection is believed to be overcome.

### **Third Rejection.**

Claims 29 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mori in view of Etzion and Crowston, and further in view of C. Gill, T. Harrison, and C. O'Ryan, *Using The Real-Time Event Service* (Gill).

With the removal of Etzion for the reasons presented above, this rejection is believed to be overcome.

### **Concluding Matters**

It is believed that the amendments and remarks presented hereinabove are fully responsive to all the grounds of rejection and objections raised by the Examiner, and that the Application is now in order for allowance.

Applicant thanks the Examiner for his thorough consideration of the Application and appreciates the careful analysis of the art cited therein.

Please charge any fees associated with this response to Deposit  
Account 09-0468.

Respectfully submitted,

By: \_\_/Suzanne Erez/\_\_\_\_\_  
Suzanne Erez  
Reg. No. 46,688  
Pone No. 1-888-260-5928

Date: 16 August 2010  
IBM Corporation  
Intellectual Property Law Dept.  
P. O. Box 218  
Yorktown Heights, New York 10598